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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,294	11/26/2001	Hong M. Dang	100111405-2	9718

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT PAPER NUMBER

3627

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/995,294

Applicant(s)

DANG ET AL

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/26/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-14 claim in their preamble an apparatus (it is noted that a system is interpreted as an apparatus), but the body of the claims recite no elements of an apparatus. Rather, only software modules, or services.

Claims 12 and 14 recite "reporting/auditing" which is indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The body of claims 10-14 recite only disembodied software modules or services, which are per se non-statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (2002/0052792).

Johnson et al show a first server comprising a merchant server and at least second and third servers, comprising tax service servers (e.g., par. 0110). It further shows a communication infrastructure linking the merchant and tax service servers. Johnson et al do not expressly show up a fourth, fifth, sixth, and seventh server. However, it is notoriously old and well known in the art to spread a functionality among any number of servers. It would have been obvious to one of ordinary skill in the art to use the additional servers in order to reduce the individual load on each server. It is noted that the servers are capable of performing all steps of the recited intended use.

Claims 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al as applied to claim 1 above, and further in view of Allon et al (5,539,883) and Taxware website.

Johnson et al show, in addition to elements noted above, an applications module, database module, tax remittance module, security module (provides for submission of

data via secure site), continuous accessibility module comprising software supporting the broadband connection. Johnson et al further show a system backup and recovery module, and a system monitoring module, since Johnson et al shows use of Windows which has these capabilities. Johnson et al do not explicitly show a load balancing module, a tax computation module, or software modules handling XML data. Allon et al show load balancing and scalability software. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Johnson et al by using a load balancing module in order to keep part of system from overloading. Taxware shows a tax module. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of Johnson et al by providing a tax computation module to minimize the software the user must have. As to sending messages in XML and it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the method of Johnson in this way in order to provide for flexible and adaptive information identification.

Regarding claims 8 and 9, as previously noted functionality can be distributed in any way among any number of servers. The system of Johnson et al further shows a server determining when a transaction request has been made.

As to claims 10-14, all recited modules are shown as discussed above.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (2002/0052792) in view of Golden et al and the Taxware website.

As to claims 15 and 16, Johnson et al inherently show subscribing a subscriber to the network, since subscribers exist and must have been subscribed (e.g., Fig. 4); installing software on the subscriber system for enabling communications (e.g., par. 0056); sending a transaction request from the subscriber to the service provider identifying class of goods, value, subscriber identification (since this information must be sent in order to prepare the proper returns), and the shipping location (e.g., par. 0074); sending a transaction request from the service provider to the tax computation module; sending a reply to the subscriber system; displaying on the subscriber system the tax due and amount of the transaction; accepting the transaction (it is noted that Johnson et al contemplates the system for use with mail order as well as ecommerce); sending a second message from the subscriber system for activating a reporting and remitting module, comprising the transaction confirmation; periodically generating a tax return based on the amount owed and reporting it to the tax authority. Johnson et al do not show that the messages are XML; the the transaction request contains the subscriber location, time of message or date; calculating taxes and sending the tax amount and total; transferring funds to a service provider account and transferring the from that account to the taxing authority. Golden et al show transferring funds to a service provider account and from there to a taxing authority periodically. It would have been obvious to one of ordinary skill in the art to modify the method of Johnson as taught by Golden et al in order to ensure payment of taxes. Taxware shows sending subscriber location, calculating taxes due for each transaction, and transmitting a message to the system with calculated tax and total amount. It would have been obvious to one of

ordinary skill in the art to further modify the method of Johnson et al by calculating and transmitting the tax amount in order to more reduce the software required by the subscriber. As to sending messages in XML and annotating them with time and date, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the method of Johnson in this way in order to provide for flexible and adaptive information identification and to provide for tracking of activity.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister

STEVE B. MCALLISTER
PRIMARY EXAMINER